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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS W. STOREY

Appeal No. 2005-1722
Application 10/420,901¹

ON BRIEF

Before BARRETT, RUGGIERO, and LEVY, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-28.

We reverse.

¶ Application for patent filed April 23, 2003, entitled "On-Line, Interactive Frequency and Award Redemption Program," which is a continuation of Application 09/441,144, filed November 12, 1999, now U.S. Patent 6,578,012, issued June 10, 2003, which is a continuation of Application 09/105,227, filed June 25, 1998, now U.S. Patent 6,009,412, issued December 28, 1999, which is a continuation of Application 08/572,017, filed December 14, 1995, now U.S. Patent 5,774,870, issued June 30, 1998.

BACKGROUND

The invention relates to an Internet-based marketing incentive system wherein award points are issued on-line in connection with a purchase and can be exchanged on-line.

Claim 1 is reproduced below.

1. An internet-based product marketing incentive system comprising:

a product presentation web page constructed and arranged to present a user with information relating to one or more products available for purchase by the user;

a product selection link constructed and arranged to enable the user to select a product presented on said product presentation web page for purchase, wherein the user is issued award points in connection with purchasing the product selected with said product selection link; and

an award presentation web page constructed and arranged to present the user with information relating to one or more awards for which the user can exchange award points.

THE REFERENCES

The examiner relies on the following references:

Cameron et al. (Cameron)	5,592,378	January 7, 1997 (filed August 19, 1994)
Gifford	5,724,424	March 3, 1998 (filed November 29, 1995)

THE REJECTION

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cameron and Gifford.

We refer to the final rejection (pages referred to as "FR__") and the examiner's answer for a statement of the

examiner's rejection, and to the brief (pages referred to as "Br__") and reply brief (pages referred to as "RBr__") for a statement of appellant's arguments thereagainst.

OPINION

Comment on examiner's objections to brief

Initially, we do not concern ourselves with the examiner's objections to the Summary of Claimed Subject Matter in the brief as being deficient for its length and discussion of dependent claims (EA2). If appellant had merely copied the specification into the summary this might be objectionable as not being a concise description. However, there is no set limit on page length. Also, the fact that appellant discusses the dependent claims even though they are not separately argued is noted, but is not objectionable. Of course, appellant can not rely on discussions of dependent claims in the summary of claimed subject matter as arguments for the separate patentability of the claims since arguments must be contained in the Argument section, see 37 CFR § 41.37(c)(1)(vii).

Obviousness

The examiner finds that Cameron teaches an Internet-based product presentation page at column 5, line 15 (FR2). The examiner finds that Cameron teaches issuing "awards" in connection with purchasing the product selected at column 20, lines 7-18, and an award presentation page at Fig. 35 and

column 20, lines 19-24 (FR2-3; EA4-5). The examiner finds that Cameron does not teach that (1) the product and award presentation pages are "web pages," and (2) the awards are "award points" (FR3; EA5).

Web pages

The examiner finds that although Cameron does not explicitly teach that the product and award pages are Web pages, they must inherently be so because the windows "look like web pages in the sense that they are GUIs and have links" (FR3) and Cameron teaches multimedia input devices "which could only be used to full effect only on the Web" (FR3). Alternatively, the examiner finds that Gifford teaches that Web pages provide multimedia capability and states that it would have been obvious to one of ordinary skill in the art to implement the presentation pages taught by Cameron as Web pages (FR3).

Appellant argues that the examiner's reasoning that if a device has multimedia capability, it must contain a Web page, is not logical (Br20). It is argued that Gifford does not state that the multimedia documents are Web pages and it is improper to assume that multimedia devices, such as the multimedia kiosk in Cameron, disclose a Web page (Br20). It is argued that the examiner's statement that because Gifford teaches Web pages have multimedia capability and Cameron teaches a multimedia kiosk, it would have been obvious to implement the pages in Cameron as Web

pages, is not a reason why a person skilled in the art would have been motivated to modify Cameron in accordance with Gifford, and no motivation exists in the references (Br20).

The examiner seems to drop the inherency finding in the answer. Nevertheless, we find that Cameron does not inherently teach Web pages. The fact that the network supports a TCP/IP protocol (col. 5, lines 15-16) indicates that the network could be the Internet, not that it must necessarily be the Internet. The examiner finds that Cameron teaches multimedia input devices at column 5, lines 18-19 (EA5; EA11). The examiner finds that Gifford teaches that Web pages provide multimedia capability and concludes that it would have been obvious to implement the presentation pages taught by Cameron as Web pages (id.). The examiner notes that Cameron teaches that the window interfaces are developed with an HTML-capable tool (id.).

Appellant responds that there is no teaching to implement the multimedia kiosks in Cameron using Web pages and there is no motivation for the modification (RBr9).

Cameron discloses a computerized order entry system having a network. The network is not described to be the Internet, but the fact that the network supports a TCP/IP protocol (col. 5, lines 15-16) indicates that the network could be the Internet. The system described in Cameron is for telemarketing in which the user is taking an order over the phone from a customer for offers

available through a catalog, but the system may be applied to other entry devices, such as a multimedia kiosk, in which the user and customer are the same person (col. 6, lines 29-36). Thus, the customer may place an order over the network. Gifford discloses a system for purchasing goods or information over the Internet. Gifford discloses that "[t]he recent rapid growth of information applications on international public packet-switched computer networks such as the Internet suggest that public computer networks have the potential to establish a new kind of open marketplace for goods and services" (col. 1, lines 7-11) and shows purchasing information on the Internet (e.g., Figs. 2-5 and 8-11 showing URLs). One of ordinary skill in the art would have motivated to make the network in Cameron the Internet with the screens displayed as Web pages in view of Gifford's disclosure of purchasing of goods over the Internet. Both references are directed to purchasing goods by computer over a network, which provides the motivation for the combination. The examiner's reasoning that it would have been obvious to combine because Cameron teaches a multimedia device and Gifford teaches a multimedia document is not persuasive because the multimedia nature of the document says nothing about the network. Thus, we conclude that the "web pages" limitation would have been obvious, albeit for reasons different than those given by the examiner.

Award points

The examiner finds that although Cameron does not explicitly teach that the awards are "award points," they must inherently be so because the structure in the reference is substantially identical to that in the claims (FR3) and because "Cameron does teach product-to-product cross selling and a promotional club (col. 20 lines 8 and 24), both of which are facilitated by a system of award points" (FR3). Alternatively, the examiner finds that "because [Cameron] does teach product-to-product cross selling and a promotional club, both of which are facilitated by a system of award points, it would have been obvious to one of ordinary skill in the art ... to add award points to the system of incentives taught by Cameron" (FR3).

Appellant argues that the marketing promotions in Cameron do not include nor suggest award points that are redeemable for awards (Br10). It is argued that there is no support for the examiner's conclusion that it would have been obvious to include award points as a promotion, and the fact that promotions may be driven by order or by customer does not disclose or suggest that the promotions may comprise award points which are redeemable for rewards (Br11). Appellants argue that Cameron's marketing promotions are intended to influence a user to make a particular purchase with which a particular promotion is associated, while

the award points of the claimed invention are intended to encourage customer loyalty (Br12).

The examiner responds that Cameron teaches a promotional club at column 20, lines 19-24, and "[b]ecause the loyalty purpose of a promotional club is enhanced by a system of award points, it would have been obvious to one of ordinary skill in the art ... to add award points to the system of incentives taught by Cameron" (EA5). The examiner discusses that it is difficult, if not impossible, to conduct a promotional/loyalty club without award points and gives the example of frequent flyer clubs in which mileage points are awarded for travel (EA9). The examiner admits that no evidence is cited, but states (EA10):

[T]he examiner is arguing that, given that Cameron et al. teaches awards obtainable through promotional clubs, one of ordinary skill in the art would find [sic, have found] it obvious to express these rewards in terms of award points. In lieu of evidence, the examiner has presented logic demonstrating that such award points are a practical necessity for a common class of awards obtained through promotional clubs, namely awards of significant value, such as airline trip awards offered through frequent flyer clubs.

That is, the examiner takes Official Notice that the existence of frequent flyer clubs was "well known" as a type of promotional club having award points.

Appellant argues that the examiner now relies on alleged "common knowledge," which constitutes a new ground of rejection (RBr2). It is argued that the "marketing promotions" of Cameron are not awards, but are incentives intended to influence a user

to make a particular purchase, in other words, to promote particular sales, whereas the "award points" of the claimed invention are to encourage customer loyalty (RBr3-4). It is argued that the examiner does not address the argument that Cameron's "marketing promotions" do not suggest "award points" that are issued in connection with a purchase and redeemable for rewards (RBr4). It is argued that the examiner incorrectly assumes that a "club" at column 20, line 24 of Cameron implies a "promotional club" or "loyalty club", but even accepting the contention, Cameron does not suggest a club that issues award points or that offers promotions for "looking up" promotions (RBr5). Appellant argues that the mere fact that Cameron's system could have been modified to incorporate award points that are redeemable for awards does not alone make the modification obvious (RBr6). As to the examiner's assertion that it is difficult to conduct a promotional/loyalty club without award points, appellant argues that the invention is not an award-based loyalty program, but an on-line implementation of such and it is not common knowledge or well known in the art or somehow inherent that promotional clubs also issue award points (RBr7). It is argued that the examiner's "logic" is no more than a hindsight recreation of the claimed invention (RBr7-8).

The "marketing promotions" described in Cameron at column 20, lines 7-12, do not include award points. We agree

with the examiner that it was well known in the art at the time of filing to provide "award points" for purchases and redemption of such award points, such as awarding frequent flyer mileage points based on mileage flown and redeeming the mileage points for flights or upgrades. Indeed, this is admitted in appellant's description of the related art (spec. at 1). However, the invention is directed to issuing the awards based on an on-line purchase and presenting information about redemption on-line, which is not taught by this finding of "well known" prior art. Documentary evidence rather than mere reasoning is required since the on-line limitations are at the very point of novelty. For example, the examiner might have shown purchase of airline tickets on-line to generate award points and redemption of award points on-line, if a reference could be found, since although it is stated that frequent flyer programs have the disadvantage of a limited list of awards, the claims cover any type of awards.

It appears that the examiner has read too much into Cameron's disclosure of looking up promotions by club at column 20, lines 19-24. Cameron describes a telemarketing example where the user, who is not the customer, can look up promotions identified by "company, source, offer number or club" (col. 20, line 24). Apparently Cameron refers to a club in which members are offered promotions of the type described at column 20, lines 8-12. Cameron does not teach or imply that the

promotions are award points. Nor does Cameron imply that the club having promotions (what the examiner calls a "promotional club") is a "loyalty club" having a loyalty purpose as assumed by the examiner. Appellant has a valid point that the promotions in Cameron are intended to promote sales of particular items and not, at least as disclosed, to promote loyalty. The examiner's rationale that the "loyalty purpose of a promotional club is enhanced by a system of award points" is without factual basis in any showing that the club offering promotions has a loyalty purpose. It appears that the examiner's rationale is no more than hindsight based on limitations read into what is meant by a club offering promotions in Cameron.

Cameron describes "application points" where "[a]n application point determines where [i.e., at what point] in the application a particular promotion will be prompted" (col. 20, lines 34-36). An "application point" is not an "award point."

For the reasons stated above, we conclude that the examiner has failed to establish a prima facie case of obviousness with respect to the issuing of "award points" in all of the independent claims. The rejection of claims 1-28 is reversed.

Dependent claims 2-7, 9-14, 16-20, and 22-26

Although we have reversed the rejection based on a lack of a prima facie case of obviousness for the independent claims, we think it is worthwhile to address appellant's argument that the examiner has failed to establish a prima facie case of obviousness with respect to the dependent claims because "the Examiner simply focuses on the features of the independent claims and is silent concerning the features of the dependent claims" (Br17) and the "Examiner simply states that Cameron inherently or obviously discloses the limitations of these claims at the citations given above" (Br17).

The examiner states that the dependent claims were addressed at paragraphs 17-20 of the final rejection and the statement that "Cameron inherently or obviously discloses the limitations of these claims at the citations given above" (FR6 ¶ 19) is a "sentence fragment, not a complete sentence ... [which] is a typo left over from a previous Office action" (EA10-11).

We agree with appellant that the examiner has failed to address the limitations of the dependent claims in any meaningful way and, thus, the rejection of the dependent claims must be reversed for this additional reason.

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CONCLUSION

The rejection of claims 1-28 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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